## REMARKS

Claims 15-16, 18-29 and 34-37 are pending in this application. Claims 15, 16 and 29 are independent.

Applicants thank the Examiner for the courtesies extended to their representative during the November 29, 2005, personal interview. Applicants thank the Examiner for the indication during the interview that the rejections over U.S. Patent No. 6,599,598 ("Tai-598") and U.S. Patent No. 6,759,107 ("Tai-107") would be withdrawn. Interview Summary dated November 29, 2005.

The present invention provides a resin composition comprising ethylene-vinyl alcohol copolymer ("EVOH") (A), an additional thermoplastic resin (B), and a transition metal salt (C). The ethylene-vinyl alcohol copolymer (A) is contained in an amount of 70 to 99.9% by weight; the thermoplastic resin (B) is contained in an amount of 0.1 to 30% by weight; and the transition metal salt (C) is contained in a ratio of 1 to 5000 ppm. As a result of this combination, the resin composition has excellent gas barrier properties (i.e. low permeability) and excellent oxygen absorption properties (oxygen scavenging function). The oxygen absorption properties result from the presence of oxygen-reactive carbon-carbon double bonds in the thermoplastic resin (B). The transition metal salt (C) improves the oxygen scavenging function of the resin composition by facilitating the reaction of carbon-carbon double bonds with oxygen.

Claims 15-16, 18-29 and 34-37 are rejected under 35 U.S.C. § 102(e) over Tai-598. In addition, Claims 15-16, 18-29 and 34-37 are rejected under 35 U.S.C. § 102(e) over Tai-107.

The Declaration Under 37 C.F.R. 1.132 filed July 20, 2005, shows that to the extent that subject matter claimed in the above-identified application is also disclosed in Tai-598 and Tai-107, the present inventors, Shinji TAI, Hiroyuki SHIMO and Masakazu NAKAYA,

are the co-inventors of the subject matter and are the only inventors of the subject matter.

Because such disclosures in Tai-598 and Tai-107 are not "by another", the rejections under 35 U.S.C. § 102(e) should be withdrawn.

The Final Rejection states:

> Applicant's declaration under 37 C.F.R. 1.132 has been considered but found unpersuasive. See MPEP 715.01(a) and 716.10 wherein the situation when applicant can overcome 102(e) rejection by submitting a declaration under 37 C.F.R. 1.132 is taught. However, it states that the subject matter claimed in the instant application was disclosed but not claimed in a patent application filed jointly by the inventor and another. However, the subject matter of the instant application was also **claimed** in the patents used in the office action (as partially evidenced by the terminal disclaimer submitted by applicant), and thus said declaration cannot remove the patents used in the office action. Final Rejection at page 2, line 19 to page 3, line 4 (emphasis in original).

However, M.P.E.P. §§ 715.01(a) and 716.10 state:

> When **subject matter, disclosed but not claimed** in a patent or application publication filed jointly **by S and another**, is **claimed** in a **later application** filed **by S**, the joint patent or application publication is a valid reference under 35 U.S.C. 102(a) or (e) ***unless*** overcome by affidavit or declaration under 37 CFR 1.131 or an **unequivocal declaration under 37 CFR 1.132 by S** that he/she conceived or **invented** the subject matter disclosed in the patent or application publication and relied on in the rejection. M.P.E.P. § 715.01(a).

> When **subject matter, disclosed but not claimed** in a patent application filed **jointly by S and another**, is **claimed** in a **later application** filed **by S**, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) ***unless*** overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an **unequivocal declaration by S** under **37 CFR 1.132** that he or she conceived or **invented** the subject matter disclosed in the patent or published application. M.P.E.P. § 716.10

Thus, the Final Rejection incorrectly focuses on the subject matter disclosed in the above-identified application, instead of on the subject matter disclosed in Tai-598 and Tai-107. The Final Rejection should ***not*** have focused on "the subject matter of the instant application".

Instead, the Final Rejection should have focused on whether "subject matter, disclosed but not claimed in a patent or application publication filed jointly by S and another, is claimed in a later application filed by S".

The subject matter claimed in the above-identified application is not claimed in Tai-598 and Tai-107. The rejections under the judicially created doctrine of obviousness-type double patenting in the Office Actions dated October 8, 2004, and March 30, 2005, which were obviated by the Terminal Disclaimer over Tai-598 and Tai-107 filed July 20, 2005, imply that the subject matter claimed in the above-identified application is not claimed in Tai-598 and Tai-107. If the subject matter claimed in the above-identified application had been claimed in Tai-598 and Tai-107, then, instead of rejecting the claims of the above-identified application for obviousness-type double patenting, the Office Actions would have issued statutory rejections based on 35 U.S.C. § 101 for "same invention" type double patenting.

The subject matter that is disclosed but not claimed in Tai-598 and Tai-107 and that is claimed in the above-identified application is the invention of only the present inventors. The Declaration Under 37 C.F.R. § 1.132 filed July 20, 2005, unequivocably states:

> 4. To the extent that subject matter claimed in the above-identified application is also disclosed in Tai-598 and Tai-107, Shinji TAI, Hiroyuki SHIMO and Masakazu NAKAYA are the co-inventors of the subject matter and are the only inventors of the subject matter. Declaration Under 37 C.F.R. § 1.132 filed July 20, 2005.

As noted in M.P.E.P. § 716.10:

> An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. M.P.E.P. § 716.10.

Because the Declaration Under 37 C.F.R. 1.132 filed July 20, 2005, unequivocably establishes that subject matter claimed in the above-identified application that is also

disclosed in Tai-598 and Tai-107 is the invention of only the present inventors, Shinji TAI, Hiroyuki SHIMO and Masakazu NAKAYA, the disclosure of this subject matter in Tai-598 and Tai-107 is not "by another". Thus, the rejections under 35 U.S.C. § 102(e) should be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Applicants respectfully request favorable consideration and prompt allowance of the application.

Should the Examiner believe that anything further is necessary in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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